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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/687,270	10/16/2003	John Gavin MacDonald	18,971	9987

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KIMBERLY-CLARK WORLDWIDE, INC.
401 NORTH LAKE STREET
NEENAH, WI 54956

EXAMINER	
NASSER, ROBERT L	
ART UNIT	**PAPER NUMBER**
3735	

DATE MAILED: 04/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/687,270	MACDONALD ET AL.	
	Examiner	Art Unit	
	Robert L. Nasser Jr.	3736	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *06 February 2006*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *50-85* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *50-75 and 77-85* is/are rejected.

7)☒ Claim(s) *76* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 50-73 and 79-85 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The examiner notes that he is not a chemist or a chemical engineer. However, upon discussing the case with another examiner, it was pointed out to this examiner that the following clarity issues needed to be addressed. Specifically, it appears that for the formula (CH3)2NC6H5, all the valences are full, i.e., no place to bond to the structure of formulas I or II, so it is unclear what the structures are. Clarification is required.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 50, 52-55, and 71 are rejected under 35 U.S.C. 102(b) as being anticipated by Springer et al 2003/0130631. Claim 50 is drawn only to the compound with an intended use. The intended use of a compound does not serve to distinguish over the same structure for a different use. Springer et al teaches the use of alpha-naphtholbenzein as a color change indicator in paragraph {0053]. Since it has the same

structure as the claim, it anticipates the claim. Claims 53 and 54 are rejected in that the indicator of Springer would react to the same substances as that of the claimed invention, since it is the identical compound. Claim 55 is rejected in that the indicator of Springer is dispose on a substrate. Claim 71 is rejected in that the examiner takes official notice that it is known to provide a compound in a dispensing device.

Claims 50, 51, 53-56, 71 and 74-75 are rejected under 35 U.S.C. 102(b) as being anticipated by Hoshino et al 3615478. Claims 50 and 52-55 are rejected under 35 U.S.C. 102(b) as being anticipated by Springer et al 2003/0130631. Claim 50 is drawn only to the compound with an intended use. The intended use of a compound does not serve to distinguish over the same structure for a different use. Hoshino et al teaches the use of michler's hydrol as a color change material. Since it has the same structure as the claim, it anticipates the claim. Claims 53 and 54 are rejected in that the material of Hoshino would react to the same substances as applicant's device, since the structure is the same. . Claim 55 is rejected in that the indicator of Hoshino Springer is dispose on a substrate. Claim 71 is rejected in that the examiner takes official notice that it is known to provide a compound in a dispensing device.

Claims 50, 51, 53-56, 71, 74, 75, and 77-78 are rejected under 35 U.S.C. 102(b) as being anticipated by Hanakura 4854332. Hanakura shows Michler's hydrol on a substrate 15 within a carrier 14. As such, it anticipates these claims.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

> the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 56-59 and 83 rejected under 35 U.S.C. 102(b) as being anticipated by Berry 3507269 in view of Cha et al 2003/008237 and Springer et al 2003/0130631. Berry shows a device for indicating bad breath that has several color change elements, one being sensitive to sulfur containing compounds (see column 2, lines 55-56) and one to amine containing compounds (see column 3, line 38). The device does not have nanoparticles in the indicator. Cha further teaches a color change indicator made from nanoparticles (see paragraph 80). From this teaching, it would have been obvious to modify the above combination to use such a color change material, as it is merely the substitution of one known indicator for another. In addition, Springer further teaches that alpha-naphthobenzein is a known color change substance. Hence, it would have been obvious to modify Berry to use such a substance, as it is merely the substitution of one known color indicator for another. Claim 57 is rejected in that the nanoparticles of Cha are 1-100 nm. With respect to claim 58, the exact surface area is not stated to be for a particular purpose or to solve a stated problem. As such, the exact surface area would have been a mere matter of design choice for one skilled in the art. Claim 59 is rejected in that the nanoparticles of Cha are silica.

Claims 60-70, 79, 80, 82, 84, and 85 rejected under 35 U.S.C. 102(b) as being anticipated by Berry 3507269 in view of Springer et al 2003/0130631. Berry shows a device for indicating bad breath that has several color change elements, one being sensitive to sulfur containing compounds (see column 2, lines 55-56) and one to amine

containing compounds (see column 3, line 38). In addition, Springer further teaches that alpha-naphthobenzein is a known color change substance. Hence, it would have been obvious to modify Berry to use such a substance, as it is merely the substitution of one known color indicator for another. . Claims 60 and 61 are rejected in that the substrate of Berry is filter paper (see column 2, lines 32-33) which is cellulose. Claims 62-66 are rejected in that applicant has not stated that the form of the indicator solves a stated problem or that it is for a particular purpose. As such, the exact form of the indicator would have been a mere matter of design choice for one skilled in the art, as all forms of the indicator appear to function equally as well. With respect to claim 67, the claim is a product by process claim. As such, the prior art need only provide teach the identical structure, regardless of how it was made (See MPEP 2113). With respect to claim 67, the combination has an indicator on a substrate, which is applied to the substrate in solution. . Hence, it anticipates the claim. With respect to claims 68 and 69, the exact indicator concentration is not stated to be for a particular purpose or to solve a stated problem. As such, the concentration would have been a mere matter of design choice for one skilled in the art. With respect to claim 70, Berry teaches using a suitable color chart to identify the degree of color change (see column 3, lines 65-68). With respect to claims 79, 81, 82, 84, and 85, the combination teaches the method.

Claims 72 and 73 are rejected under 35 U.S.C. 103(a) as being unpatentable over Berry in view of and Springer et al, Pedersen 6607711 and Withers et al 5,245,117. The Berry/Springer combination teaches a breath indicator as discussed above. Pedersen teaches in the background paragraphs 64 and 70 and in the

description at paragraph 89, for example, teach using a halimeter (bad breath tester) to determine the effects of a breath freshener. Therefore, it would have been obvious to modify Berry to use its device to test how well a freshener works, as it is merely the use of the device for a known method. The combination does not have a dispenser, e.g. container, containing the testing device and the breath freshener. Withers et al teaches a diabetes kit which includes both a glucose testing device and an insulin supply. As such, it has a testing means and a treating means in the same device to provide ease of treatment for the user. The Federal Circuit has established that a reference is good for all it teaches. When applied here, Withers teaches modifying the above combination to use a single container, to simplify the treatment process.

Claims 76 and 81 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims. Claim 76 defines over the art in that none of the art shows the compound in combination with nanoparticles. Claim 81 is rejected in that none of the art teaches using michler's hydrol as a breath indicator.

Applicant's arguments filed 2/6/2006 have been fully considered but they are moot in view of the new grounds of rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert L. Nasser Jr. whose telephone number is 571 272-4731. The examiner can normally be reached on 9:30 - 6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Max Hindenberg can be reached on 571 272-4726. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

RLN
April 17, 2006

ROBERT L. NISSER
PRIMARY EXAMINER